

REMARKS

This Response is submitted in response to the Office Action dated November 29, 2006. Claims 1, 12, 30, 42, 47, 48 and 49 have been amended to further clarify the claimed inventions. Claims 51 to 53 have been added. No new matter has been added by these amendments or the new claims. Please charge Deposit Account No. 02-1818 for any fees due.

The Office Action rejected Claims 1 to 50 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,875,108 to Hughs-Baird ("*Hughs*") in view of Price is Right. Applicants respectfully disagree with and traverse these rejections for the reasons discussed below.

Hughs should be disqualified as prior art as to the claimed invention under 35 U.S.C. 103(c)(1). First, in accordance with the statute, *Hughs* was pending on or after December 10, 2004. Second, the subject matter of *Hughs* and the claimed invention were, at the time the invention was made, owned by IGT. This common ownership is evidenced by the assignment of the *Hughs* patent to IGT recorded with the Patent Office at Reel/Frame: 011478 /0990 on January 25, 2001, and the assignment of the present application to IGT recorded with the Patent Office at Reel/Frame: 012113 /0089 on August 20, 2001, the date of filing of the present application. Therefore, Applicants respectfully submit that *Hughs* should be disqualified as prior art.

The Office Action relies on the "Any Number" and the "Side-by Side" Price is Right games to cure the deficiencies of *Hughs* as to each of the independent claims. However, the Price is Right games fail to disclose each and every element of the claimed invention.

The *Any Number* game displays spaces for digits in the prices of three different prizes including the price of a car. The first digit in the price of the car is revealed to the player, and the player is asked to pick a single digit (0 to 9). The number picked by the player is revealed in the appropriate space of the one of the prices of the three prizes. The player continues to pick digits until all of the numbers in the price of one of the

prizes are revealed. The first prize to have all of the digits in its price revealed is provided to the player.

In *Side-by-Side*, two pairs of two-digit numbers in the price of a prize are displayed one above the other. The player picks whether the top pair of numbers should be placed on the left or right of the bottom set of numbers to form the correct price of the prize. Therefore, in both Price is Right games, the numbers are displayed to, or chosen by, the player before the player positions the numbers.

Accordingly, the Price is Right games do not disclose a processor operable with a display device and an input device to display a plurality of positions without displaying numbers to be associated with the positions as recited in Claim 1.

The Price is Right games do not disclose a processor operable with a display device and an input device to enable a player to arrange at least two of a plurality of masked numbers in an order decided by the player to form a displayed value on which an amount of an award is based as in Claim 12.

The Price is Right games do not disclose a processor operable with a display device and an input device to enable a player to associate selections with a plurality of positions and to display numbers associated with the selections upon association of the selections with the positions to form a value on which an award is based as in Claim 30.

The Price is Right games do not disclose a selection orderer operable with a processor to enable a player to select at least two selections and order the selections in digit positions of an award and to reveal the award upon ordering the selections in the digit positions selected by the player by displaying a number associated with each selection in the digit positions to form a displayed value on which the award is based as in Claim 42.

The Price is Right games do not disclose a processor operable with a display device and an input device to associate numbers with selections without displaying the numbers associated with the selections until a player is enabled to associate selections with a one's digit and a ten's digit of an award to form a value on which the award is based as in Claim 47.

The Price is Right games do not disclose a processor operable with a display device and an input device to associate numbers with selections without displaying the numbers associated with the selections until a player is enabled to associate selections with a one's digit and a ten's digit of an award to form a value on which the award is based as in Claim 48.

The Price is Right games do not disclose a processor operable with a display device and an input device to associate numbers with the selections without displaying the numbers associated with the selections until a player is enabled to associate the selections with the number of possible digits of the award provided by the initial determination to form a value on which the award is based as in Claim 49. Therefore, the Price is Right games do not disclose each and every element of the claimed invention.

For at least these reasons, Applicants respectfully submit that Claims 1, 12, 30, 42, 47, 48 and 49 are in condition for allowance. Applicants further submit that Claims 2-11, 13-29, 31-41, 43-46 and 50 which depend from Claims 1, 12, 30 and 42 and 49, respectively, are also in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully request that the Examiner contact the undersigned.

Respectfully submitted,

BELL, BOYD & LLOYD LLP

BY Adam H. Masia

Adam H. Masia
Reg. No. 35,602
Customer No. 29159

Dated: January 29, 2007